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PATENT
Attorney Docket No. 066079-5128-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE: Patent Application of)
Inventors: JAMES *et al.*)
Serial No.: 10/576,936)
Filed: April 24, 2006)
For: PROCESS)

RENEWED PETITION UNDER 37 C.F.R. § 1.47

U.S. Patent and Trademark Office
Assistant Commissioner for Patents
Mail Stop PCT
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Decision on Petition dated March 19, 2007, the applicants file this Renewed Petition under 37 C.F.R. § 1.47(a) to request reconsideration of the dismissal of the earlier petition.

In support of this request for reconsideration, the applicants submit the attached Supplemental Declaration by Amanda Collier. The declaration provides further information required by the Decision on Petition. In particular, it is thought that the declaration responds to all of the points made in the Decision in dismissing the applicants' earlier Petition. The declaration confirms that the now deceased inventor Cottrell had the present application papers, knew the subject matter thereof represented an invention of his, understood the need for his signed application declaration and refused to sign because he had been made redundant subsequent to his invention, notwithstanding his employment obligations to sign the declaration. Mr. Cottrell's last known address is also confirmed.


It is respectfully requested that the earlier decision to deny the applicants' petition be reconsidered, on the basis of the attached, and that the application be accepted as complete for examination purposes, notwithstanding Mr. Cottrell's refusal to sign the declaration.

No additional petition fee is required. However, please charge any other fees that may be required against Deposit Account 50-0310 (Order No. 066079-5128).

Favorable action on this petition is requested.

Respectfully submitted,

MORGAN LEWIS & BACCHIUS LLP

By: 
Paul N. Kokulis
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Date: April 26, 2007

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PATENT
Attorney Docket No. 066079-5128-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In RE: Patent Application of)	
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Inventors: JAMES <i>et al.</i>)	
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Serial No.: 10/576.936)	Group Art Unit: unassigned
)	
Filed: April 24, 2006)	Examiner: unassigned
)	
For: PROCESS)	

SUPPLEMENTAL DECLARATION OF AMANDA COLLIER

U.S. Patent and Trademark Office
Assistant Commissioner for Patents
Mail Stop PCT
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Amanda Collier, declare as follows:

1. I am the same Amanda Collier whose declaration was filed with Petition under 37 C.F.R. 1.47(a) in the above matter.
2. As stated in my earlier declaration, I am a formalities specialist in the patent department at Fujifilm Imaging Colorants Limited (hereinafter "Fujifilm"), a company located in Manchester, England and formerly known as Avecia Inkjet Limited, a part of Avecia Limited, both also of Manchester, England. I have acted in this capacity for Avecia Limited and Avecia Inkjet Limited and now for Fujifilm.
3. I have reviewed the Decision on Petition and state that, based on the communications referred to in my earlier declaration, it was and is my belief and understanding that Mr. Cottrell had the subject U.S. application papers, including specification, declaration and assignment, in hand and fully understood the purpose and need to have these papers duly signed and returned to me to complete the U.S. filing. It is also my belief and understanding that the only reason Mr. Cottrell refused to sign the papers was because he had been released from employment (i.e. made redundant) by his employer Avecia Limited. Despite his termination,

however, Mr. Cottrell remained under obligation to sign any papers which might be required with respect to inventions he made while employed by Avecia.

4. I confirm that the address provided in paragraph 21 of my earlier-filed declaration (*i.e.*, 12 Linksway, Upton-by-Chester, Cheshire CH2 1EA) was indeed the last known address of David Cottrell of which we were aware. The application papers were initially sent to Mr. Cottrell at 16 Linksway, Upton-by-Chester, Cheshire, CH2 1EA. See **Exhibit 7** of my earlier declaration. However, I later found from Avecia's Human Resources group that he had changed his address from 16 Linksway to 12 Linksway in Upton-by-Chester, Cheshire CH2 1EA and further correspondence with him was directed to the 12 Linksway address. See **Exhibits 8, 9 and 10** of my earlier declaration.

5. Notwithstanding Mr. Cottrell's move from 16 Linksway to 12 Linksway, it was evident to me, particularly on the basis of his e-mail of September 1, 2006 (see **Exhibit 11** of my earlier declaration), that he had possession of the application papers. I note in this regard that, with my letter of August 23, 2006 (**Exhibit 10** of my earlier declaration), I re-sent the application to him with a further set of the forms (declaration and assignment) to his 12 Linksway address. He responded by his e-mail of September 1, 2006 stating that "I now have the appropriate letters you supplied." I know that the application, declaration and assignment were included with my letter of August 23, 2006 (**Exhibit 10** of my earlier declaration) and his e-mail confirms receipt. His e-mail also stated that "the patent concerned was developed a few weeks before" he was made redundant by Avecia. He would not have known what the "patent" related to without having the application before him and his comment made it clear to me that he recognized the invention as at least partly his. In short, I am satisfied that Mr. Cottrell had possession of the application papers which had been sent to him, that he was fully aware of the nature and scope of the patent application and what he was being asked to do, and why.

6. I note that the Decision on Petition states that "... it is not clear whether a copy of this application was sent to him (Mr. Cottrell) since Ms. Collier's correspondence does not explicitly recite an application number; instead, it merely recites a case reference number which does not correspond to the present docket number of this application". In response, I confirm that the application sent to Mr. Cottrell and identified as SMC 60622/UST was in fact the same as the subject U.S. application. I note in this regard that the in-house Avecia/Fujifilm

designation for this case was and is SMC 60622/UST, the UST indicating that it is the U.S. filing for docket SMC 60622. I used this identification in my correspondence with Mr. Cottrell. See, for example, **Exhibit 5** of my earlier declaration. The in-house designation used by our U.S. attorneys for this same application is 066079-5128. See **Exhibits 4, 6, 12, 13 and 14** of my earlier declaration which make it clear that SMC 60622/UST and 066079-5128 stand for the same application. I further note that the subject U.S. application is a national phase filing based on PCT/GB2004/004186 and PCT papers of record in the U.S. file tie together the present application with the SMC 60622 case designation. See, for example, the attached **Exhibits 16 and 17**, which represent, respectively, the first page of the PCT Notification of Transmittal of the International Search Report and the first page of the International Search Report, both of record in the file of the subject application and refer to SMC 60622WO, the WO indicating the PCT filing for the same docket SMC 60622. There is, therefore, no doubt that the application sent to Mr. Cottrell was the subject application.


7. The Decision on Petition states that it is unclear whether Mr. Cottrell's e-mail evidenced a refusal to execute the application or instead suggested that he did not understand his interest in the area and might have been willing to sign the declaration if he had been apprised of the reasons why his participation was still relevant and necessary (§ bridging pages 2-3 of Decision on Petition). However, my letters of June 7, 2006; June 29, 2006; July 28, 2006 and August 23, 2006 (**Exhibits 7, 8, 9 and 10**, respectively, of my earlier declaration) made it clear that the papers were sent to him for signature as an inventor and it was clear to me and others in the Avecia Patent Department that what Mr. Cottrell meant in his e-mail was that since he had been made redundant by Avecia and, therefore, was no longer considered necessary by Avecia as an employee, there should be no need for him to help Avecia, in any way, notwithstanding the fact that he was named as an inventor and had a pre-existing obligation to sign the application papers as an inventor. I note that Mr. Cottrell's joint inventor James had also been made redundant by Avecia but he signed the application papers, nevertheless, recognizing that this was part of his standing obligation to the company.

8. Regarding the suggestion in the Decision that Mr. Cottrell may have been willing to execute the declaration if he had been made aware of the reasons his participation was still relevant and necessary, I note in this regard that Mr. Cottrell had filed applications before as an

inventor for Avecia and was fully knowledgeable of the need to obtain a declaration signed by the inventor(s) for U.S. patent applications. His e-mail to me (**Exhibit 11** of my earlier declaration) states "The patent concerned was developed a few weeks before I was made redundant after 22 years of service." This indicates to me that he recognized the invention described in the application was at least partly his. I am satisfied that Mr. Cottrell fully understood what was needed and why, as an inventor, he was being asked to sign the application declaration and assignment. It was also evident to me that his sole reason for refusing to sign these papers was because he had been made redundant by the company and felt that, in the circumstances, he would not do what his prior employment obligations required him to do.

9. In the circumstances, it was my understanding that we had done all that we could to persuade Mr. Cottrell to sign the application papers and that he would continue to refuse to do so up to his unfortunate death shortly afterwards.

10. The undersigned declares that all statements made herein of my personal knowledge are true and that all statements made on information and belief are believed true; and further that these statement were made with the knowledge that any willful false statements are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that any willful false statements may jeopardize the validity of said application or patent issuing therefrom.



Amanda J. Collier

Date: 18 April 2007

PATENT COOPERATION TREATY

*Revised
to 31/10/05*

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT AND
THE WRITTEN OPINION OF THE INTERNATIONAL
SEARCHING AUTHORITY, OR THE DECLARATION

To:

AVECIA LIMITED
Intellectual Property Group
Attn. Mayall, John
PO Box 42, Hexagon House
Blackley
Manchester M9 8ZS
UNITED KINGDOM

(PCT Rule 44.1)

Date of mailing
(day/month/year)

14/01/2005

Applicant's or agent's file reference

SMC 60622/WO

FOR FURTHER ACTION

See paragraphs 1 and 4 below

International application No.

PCT/GB2004/004186

International filing date
(day/month/year)

01/10/2004

Applicant

AVECIA LIMITED

1. ☒ The applicant is hereby notified that the international search report and the written opinion of the International Searching Authority have been established and are transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the International Application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the International Search Report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO, 34 chemin des Colombettes
1211 Geneva 20, Switzerland, Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no international search report will be established and that the declaration under Article 17(2)(a) to that effect and the written opinion of the International Searching Authority are transmitted herewith.
3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

- ☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.
- ☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. Reminders

Shortly after the expiration of **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

The applicant may submit comments on an informal basis on the written opinion of the International Searching Authority to the International Bureau. The International Bureau will send a copy of such comments to all designated Offices unless an international preliminary examination report has been or is to be established. These comments would also be made available to the public but not before the expiration of 30 months from the priority date.

Within **19 months** from the priority date, but only in respect of some designated Offices, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until **30 months** from the priority date (in some Offices even later); otherwise, the applicant must, within **20 months** from the priority date, perform the prescribed acts for entry into the national phase before those designated Offices.

In respect of other designated Offices, the time limit of **30 months** (or later) will apply even if no demand is filed within 19 months.

See the Annex to Form PCT/IB/301 and, for details about the applicable time limits, Office by Office, see the *PCT Applicant's Guide*, Volume II, National Chapters and the WIPO Internet site.

Name and mailing address of the International Searching Authority



European Patent Office, P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl.
Fax: (+31-70) 340-3016

Authorized officer

Véronique Baillou

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference SMC 60622/WO	FOR FURTHER ACTION		see Form PCT/ISA/220 as well as, where applicable, item 5 below.
International application No. PCT/GB2004/004186	International filing date (day/month/year) 01/10/2004	(Earliest) Priority Date (day/month/year) 25/10/2003	
Applicant AVECIA LIMITED			

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 4 sheets.

☒ It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ The international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

b. ☐ With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, see Box No. I.

2. ☐ **Certain claims were found unsearchable** (See Box II).

3. ☐ **Unity of invention is lacking** (see Box III).

4. With regard to the **title**,

☐ the text is approved as submitted by the applicant.

☒ the text has been established by this Authority to read as follows:

PROCESS FOR ETCHING METAL AND ALLOY SURFACES

5. With regard to the **abstract**,

☐ the text is approved as submitted by the applicant.

☒ the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box No. IV. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. With regards to the **drawings**,

a. the figure of the **drawings** to be published with the abstract is Figure No. _____

☐ as suggested by the applicant.

☐ as selected by this Authority, because the applicant failed to suggest a figure.

☐ as selected by this Authority, because this figure better characterizes the invention.

b. ☒ none of the figures is to be published with the abstract.